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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,447	05/25/1999	PERI HARTMAN	23984-12275	1430
758 7590 09/29/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
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09/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/318,447

Applicant(s)

HARTMAN ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 108-117, 124, 125, 151-155, 157 and 176-183 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 108-117, 124, 125, 151-155, 157, 176-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 1/24/2008 which was received 7/24/2008 and 9/16/2008. Acknowledgement is made to the cancellation of claims 1-108,118-123,126-150,156,158-175, amendment to claims 108,151 and 176, leaving claims 108-117,124,125,151-155,157,176-183 open to prosecution. The examiner has carefully considered applicant's response and finds it persuasive, however after further consideration the following new ground of rejection necessitated by amendment follows:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 117,156, and 183 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 117,156, and 183 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a shopping cart web page that may include separate functionality such as one click ordering ("411", col 7, lines 15-23), does not reasonably provide enablement for a one click order utilizing a shopping cart model, in fact applicant's specification teaches that the old and well known shopping cart model is not used in the one click operation ("411" col 4, lines 5-20 and col 2, lines 20-45). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make a one click order utilizing a shopping cart model and therefore exercise the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 108,113,117,154,155,176,180,183, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claims 108,113,117,154,155,176,180,183, the recited conditional limitations “when” and “alternatively” do not move to distinguish the claimed invention from the cited art. These phrases are conditional limitations with the noted step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C]. In this case the positive recitation will be considered and the alternative will not be considered in the response to the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 108-112 and 117 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirsch (US 5,963,915).

In regards to claim 108, Kirsch discloses a method in a client system for ordering an item, the method comprising:

receiving from a server system a client identifier of the client system (cookie data col 8, lines 10-20); persistently storing the client identifier at the client system (Abstract);

when an item is to be ordered, displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item (col 8, lines 64 - col 9, lines 4); and

in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier (col 8, lines 10-35),

the client identifier identifying account information previously supplied by a user of the client system (col 8, lines 13-20)

such that the user does not need to log in to the server system when ordering the item (this feature does not further limit the claim and is therefore given little patentable weight (MPEP 2106 and 2111.04)); and

when account information is to be changed,
coordinating the log in of the user to the server system; receiving updated account information; and

sending the updated account information to the server system (col 5, lines 22-27 and col 14, lines 45-65)

In regards to claim 109, Kirsch teaches wherein the account information includes billing information (col 12, line 55 – 67).

In regards to claim 110, Kirsch teaches wherein the account information includes shipping information (col 12, line 55 – 67).

In regards to claim 111, Kirsch teaches wherein the client system and server system communicate via the Internet (FIG 1).

In regards to claim 112, Kirsch teaches receiving from the server system a confirmation that the order was generated (col 8, lines 25-34).

In regards to claim 117, Kirsch teaches wherein the item may alternatively be ordered using a shopping cart model (see USC 112 rejection).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 113,114-116 ,124 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (US 5,963,915) in view of Admitted Prior Art (APA) US Patent to Hartman (US 5,960,441) and further in view of Official Notice

In regards to claim 113, the prior art does not specifically teach “the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information”, it is noted that Kirsch teaches a single mouse click (Kirsch col 9, lines 1-3). As per “the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information” feature, per se, there is no indication in the specification that the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information provides advantages over teaching of the prior art in fact APA teaches that prior to the single action multiple physical movements may occur and that one example would be clicking a mouse button when a cursor is positioned over a predefined area of the displayed information (“411” col 10 lines 3-5). Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kirsch to include that the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information, because it would advantageously allow the mouse to be physically moved to the point where the single action may be actuated.

In regards to claim 114-116, the examiner takes Official Notice that displaying partial information to protect the users personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Kirsch, Klincewicz and Kennedy, providing

partial information, because providing only partial information has notoriously been known to protect the users identity and personal information from theft.

In regards to claim 124 and 125, Kirsch teaches a display screen for providing information interactively with a user and permitting cancellation of orders, but does not specifically mention that the information provided is an indication that "You can cancel within 90 minutes" (applicant's drawing FIG 1A). Since the limitation of indicating does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable moment. The examiner further takes Official Notice that it was old and well known in the art to include general information that was considered informative to the user. It would have been obvious to a person having ordinary skill in the art to include in Kirsch this type of informative information such as "You can always cancel within 90 minutes", because this information is informative and can provide information that is useful to the user.

Claims 151-157 and 176-183 contain similar features as those addressed above and are rejected for the same rationale

Response to Arguments

Applicant's arguments with respect to claims 108-117,124,125,151-155,157,176-183 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Official Notice

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/

Primary Examiner, Art Unit 3625